

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. BYERS

Appeal No. 97-3000
Application 08/370,867¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and COHEN and
FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed January 10, 1995.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 15, all of the claims pending in this application.²

Appellant's invention relates to a frame for pictorial matter, such as hobby cards and photographs. As best seen in Figures 3 through 9 and 14, the frame includes front and back viewing panels (16) of clear plastic formed as window modules (18) and (20) respectively, top and bottom edge members (50), and opposite side edge members (90). Each of the top, bottom and opposite side edge members includes a channel (e.g., 78, 104) along its inner side for closely receiving therein respective top, bottom, and opposite side areas of the window modules (18, 20). When assembled together with the viewing panels, the ends of the top and bottom edge members are secured to the ends of the opposite side edge members via securing posts (68, 70) on the top

² Claim 1 has been amended (subsequent to the final rejection) in a paper filed December 13, 1996 (Paper No. 7). As indicated in the advisory action mailed January 10, 1997 (Paper No. 8) the rejection of claims 1 through 8 under 35 U.S.C. § 112, second paragraph, in the final rejection has been overcome by the above-noted amendment.

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and bottom edge members which are received in holes (112, 114) at the ends of the side edge members. Claim 1 is representative of the subject matter on appeal and a copy of that claim is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Waller et al. (Waller)	2,823,472	Feb. 18, 1958
Abatiell	3,426,913	Feb. 11, 1969
Lyman	4,271,618	June 9, 1981
Astolfi	4,989,353	Feb. 5, 1991

Claims 1 through 4, 9, 12, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lyman.

Claims 5 through 7 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lyman in view of Astolfi.

Claims 8 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lyman in view of Waller.

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Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lyman in view of Abatiell.

Reference is made to the examiner's answer (Paper No. 11, mailed March 11, 1997) for the examiner's reasoning in support of the above-noted rejections and to appellant's brief (Paper No. 10, filed February 11, 1997) for appellant's arguments thereagainst.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we find that we are unable to sustain any of the examiner's rejections of the appealed claims. Our reasoning follows.

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In rejecting claims 1 through 4, 9, 12, 14 and 15 under 35 U.S.C. § 103 relying on Lyman, the examiner has recognized that Lyman fails to disclose, teach or suggest a photographic

display or frame for pictorial matter which includes "separate left and right edge members defining channels or top and bottom edge members defining channels receiving the left, right, top and bottom sides of the panels" (answer, page 3). To address these differences between the applied prior art and the claimed subject matter, the examiner has urged that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the side, top and bottom edge members into the front and back viewing panels, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art.

It is apparent to us from the examiner's foregoing statement of "obviousness" that the examiner has misapplied the above-noted precept of patent law concerning elimination of an element and its function (set forth in cases such as In re Larson, 340 F.2d 965, 969, 144 USPQ 347, 350 (CCPA 1965) and In

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re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)) by attempting to apply this legal precedent to the claimed invention instead of to the prior art photographic display of Lyman. It is well settled that for the Patent and Trademark Office (PTO) to

establish a case for obviousness in the first instance, it is necessary for the examiner to ascertain whether or not the reference teachings of the applied prior art would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modification. See, e.g., In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). Stated another way, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of appellant's invention. See, e.g., In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.,

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776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985),
cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.
Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.
Cir. 1984).

In the present case it is clear to us that the applied
prior art patent to Lyman has no teachings that are relevant to,

or in any way establish the obviousness of, the left and right
side edge members, the top and bottom edge members, or the means
for securing the ends of the top and bottom edge members to the
ends of the respective left and right side edge members, as set
forth in appellant's independent claim 1 on appeal, or the same
structure defined in somewhat different language in independent
claims 9 and 12 on appeal. Given this determination, it follows
that we will not sustain the examiner's rejection of claims 1
through 4, 9, 12, 14 and 15 under 35 U.S.C. § 103 as being
unpatentable over Lyman.

A review of the patents to Astolfi, Waller and
Abatiell, applied by the examiner against dependent claims 5

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through 8, 10, 11 and 13 on appeal, reveals nothing which would supply that which we have noted above to be lacking in the basic teachings of the Lyman reference. Accordingly, the rejections of these claims under 35 U.S.C. § 103 will likewise not be sustained.

To summarize:

We have not sustained any of the examiner's rejections of the appealed claims under 35 U.S.C. § 103, and the decision of the examiner is, therefore, reversed.

REVERSED

BRUCE H. STONER, JR.)
Chief Administrative Patent Judge)

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IRWIN CHARLES COHEN
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

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APPENDIX

1. A frame for pictorial matter, comprising:

front and back viewing panels each formed of clear plastic with inside and outside surfaces, and being interlocked together to have opposite left and right sides, and top and bottom sides forming an outer periphery, said viewing panel being capable of containing said pictorial matter therebetween;

left and right side edge members each formed to have a smooth outer sided, front side, rear side and inner side while defining a channel along the inner side, said left and right sides of the viewing panel being closely contained within the respective channels of said left and right side edge members;

top and bottom edge members each formed to have a smooth outer side, front side, rear side and inner side while defining a channel along the inner side, said top and bottom sides of the viewing panel being closely contained within the respective channels of said top and bottom edge members; and

means for securing the ends of top and bottom edge members to the ends of respective left and right side edge members to form the corners of a rectangular frame.